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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONG-SHIN JUNG and KYOUNG-HOON YI

Appeal 2009-008034
Application 10/748,167
Technology Center 2100

Before JOHN A. JEFFERY, DEBRA K. STEPHENS, and
JAMES R. HUGHES, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-27. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants' invention provides information on objects included in content without modifying the content. *See generally* Spec. ¶¶ 02, 07-15.

Claim 1 is illustrative with the key disputed limitation emphasized:

1. An apparatus for providing object-in-content information, managed by an object-in-content information managing device, comprising:

a central control unit operable to receive content, supply basic content information of the content, and provide the object-in-content information in a user-viewable format; and

an object information interface unit operable to transmit a request message including the basic content information to the object-in-content information managing device, receive a response message including the object-in-content information corresponding to the basic content information from the object-in-content information managing device, and transmit the object-in-content information included in the response message to the central control unit,

wherein the received content is not received through the object-in-content information managing device.

The Examiner relies on the following as evidence of unpatentability:

Astiz	US 5,918,012	June 29, 1999
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THE REJECTION

The Examiner rejected claims 1-27 under 35 U.S.C. § 102(b) as anticipated by Astiz. Ans. 3-10.²

² Throughout this opinion, we refer to (1) the Appeal Brief filed July 1, 2008; (2) the Examiner's Answer mailed September 5, 2008; and (3) the Reply Brief filed November 5, 2008.

CONTENTIONS

Regarding independent claim 1, the Examiner finds that Astiz discloses every recited feature including an “object-in-content information managing device” which the Examiner equates to Astiz’s HTTP server 33 in view of its ability to receive and process position and time data ((x, y, t) data) corresponding to a user’s selection via a pointing device in a video viewer—data that the Examiner equates to the recited “basic content information.” Ans. 3-5, 11-12. The Examiner reasons that since (1) Astiz contemplates using multiple HTTP servers, and (2) Astiz’s HTTP server location is configurable, then Astiz’s system would be “inherently capable” of not receiving viewable and playable content through the specified “object-in-content information managing device” (HTTP server 33) since the user could simply select a different server. Ans. 5, 11-14.

Appellants challenge the Examiner’s anticipation position as based on mere possibilities, and contend that the Examiner does not establish that Astiz’s received video content is *necessarily* not received through the “object-in-content information managing device” (i.e., the HTTP server 33) as claimed. App. Br. 14-17; Reply Br. 4-8. Appellants emphasize that even if Astiz’s invention were configurable as the Examiner contends, the URL of the selected content would not *necessarily* be located at a different HTTP server that received the (x, y, t) data. Reply Br. 7. Appellants make similar arguments regarding claim 2. App. Br. 17; Reply Br. 8. The issues before us, then, are as follows:

ISSUES

Under § 102, has the Examiner erred by finding that (1) received content in Astiz is necessarily not received through the specified object-in-content information managing device as recited in claim 1, and (2) Astiz's object information transmitting unit does not necessarily transmit the content to the central control unit as recited in claim 2?

FINDINGS OF FACT (FF)

1. Astiz's system enables users to access and view video content via a browser 32 and associated viewer 31 contained within a data processor 30. Users can also select particular hyperlinks associated with the video as it plays to retrieve additional content. Astiz, Abstract; col. 6, l. 1 – col. 7, l. 18; Figs. 3-4.

2. The browser (1) receives information from the internet network via the data processor's HTTP server 33, and (2) translates that HTML data into a screen display that the user can recognize. When the browser receives HTML data from the HTTP server 33 in a format that requires an associated viewer, the browser initiates opening the viewer and downloading the data file to the viewer. Astiz, col. 6, ll. 1-17; Fig. 3.

3. When the user clicks on a hypertext word on the browser's screen 42, the browser issues a URL request to the HTTP server to obtain a video data file from some IP address on the internet shown in Figure 1. When the browser receives the video data file from the HTTP server 33 (Figure 3 or

Figure 1), the browser recognizes from the “.BTV” MIME³ that it must open the associated BTV viewer 31 and download the BTV data file to the viewer for display. Astiz, col. 6, ll. 33-45; Figs. 1, 3-4.

4. When the user positions and clicks a pointing device at a particular portion of a video playing on the viewer screen 41, the viewer 31 sends the following information to the browser: (1) “(x, y, t) data” (representing the click’s position and time) for processing into a URL code, and (2) locations of associated CGI script and image map files (obtained from the header of the .BTV file). Astiz, col. 6, l. 64 – col. 8, l. 5; Fig. 3.

5. The browser then sends this information to the HTTP server 33 specified in the CGI URL (from the header) which then retrieves the appropriate script file 34 from a local file server. Astiz, col. 8, ll. 6-11; Fig. 3.

6. Astiz’s Figure 9 shows a file header utility for converting a standard video file (e.g., an “.AVI” file) into a “.BTV” file. The information for the header includes (1) the CGI URL (the URL where the HTTP server 33 can find the video map script 34); (2) the map location; and (3) the location of the original, unaltered video file in the .AVI MIME format. Astiz, col. 5, ll. 47-48; col. 12, ll. 29-38; Fig. 9. Astiz’s BTV file header utility in Figure 9 is reproduced below:

³ “MIME” stands for Multipurpose Internet Mail Extension. Astiz, col. 4, l. 46.

BTV HEADER

CGI URL: [SCRIPT NAME]

MAP LOCATION: [MAP NAME]

AVI FILE: C:\PROJECTS\VIDEO\HLS\200706.AVI

BTV OPTIONS

☒ ALLOW LOCAL SAVE ☒ ALLOW STOPPING

☒ ALLOW PAUSE ☒ PAUSE AFTER FIRST CLICK

☒ START ON RECEIPT

☐ IGNORE FIRST [0] CLICKS

STORE AND SEND [1] CLICKS

☒ DO NOT LOOP (PLAY ONCE)

☐ LOOP CONTINUOUSLY

☐ LOOP [1] TIME [s]

SAVE AS CLOSE

Astiz's BTV File Header Utility in Figure 9

7. According to Appellants' Specification, "'content' refers to any material in a user-viewable format, for example, a program being broadcast over a separate channel by a broadcasting station." Spec. ¶ 13.

8. Astiz's Figure 1 shows an internet network with multiple HTTP servers, each set of servers associated with different LANs (i.e., "LAN #1" and "LAN #2", respectively).

PRINCIPLES OF LAW

"Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted).

ANALYSIS

Claims 1, 4, and 7-27

Based on the record before us, we find error in the Examiner's anticipation rejection of independent claim 1 which calls for, in pertinent part, that the content received by the central control unit is not received through the object-in-content information managing device.

In reaching this conclusion, we agree with Appellants (App. Br. 14-17; Reply Br. 4-8) that the Examiner has failed to show that Astiz's received video content is *necessarily* not received through the specified "object-in-content information managing device," namely the HTTP server 33—a crucial requirement for inherent anticipation. *See Robertson*, 169 F.3d at 745. Although the Examiner's interpretation of "content" (Ans. 11) as playable and viewable media reasonably comports with Appellants' definition of the term (FF 7), and Astiz contemplates providing multiple HTTP servers in an internet network (FF 8), we cannot say that received viewable content in Astiz would *necessarily* not be received by the HTTP server 33 as the Examiner contends. In fact, Astiz's repeated references to *the* HTTP server 33 (FF 2-3, 5) as receiving this viewable content suggests just the opposite.

Although Astiz indicates that this HTTP server can correspond to those shown in Figure 3 *or Figure 1* (FF 3)—a figure that shows multiple HTTP servers as the Examiner indicates (FF 8; Ans. 13)—that hardly means that the received content would *necessarily* be received through a different server. Indeed, even if it were probable that a different server in Astiz received the viewable content as the Examiner seems to suggest, that too would be insufficient to establish anticipation. *See Robertson*, 169 F.3d at

745. The Examiner's reliance on Astiz's alleged "inherent capability" to store data on multiple HTTP servers (Ans. 12-13) is simply unavailing to show that the apparatus of claim 1 necessarily contains the recited feature.

We reach this conclusion acknowledging that users can specify a particular HTTP server in a file header. FF 5-6. Despite Astiz's utility that enables users to specify different servers for the CGI URL and video (AVI) file (FF 6), this feature hardly means that users would *necessarily* select different servers as the Examiner seems to suggest (Ans. 13). That the Examiner repeatedly uses permissive, optional terms in this regard⁴ only bolsters this conclusion.

We are therefore persuaded that the Examiner erred in rejecting (1) independent claim 1; (2) independent claims 7, 12, 15, 20, and 25 which recite commensurate limitations; and (3) claims dependent thereon for similar reasons.

Claims 2, 3, 5, and 6

We reach a similar conclusion regarding the Examiner's anticipation rejection of independent claim 2 which calls for the object information transmitting unit to not transmit the content to the central control unit. Although this limitation is somewhat different from the disputed limitation

⁴ See Ans. 13 (noting that "multiple HTTP servers *can be* used within the context of [Astiz's] invention"); *see also id.* (noting that since Astiz's object-in-content information managing device is configurable, "it *can be* changed to a different HTTP server other than the HTTP server where the video (received content) resides"); *id.* (noting that various storage locations associated with BTV files "*may be* changed to different servers on the network" via Astiz's user interface in Figure 9) (emphases added).

of claim 1, the Examiner nonetheless relies on a similar rationale as that indicated for claim 1 (Ans. 5-7, 14)—a rationale that we find problematic for anticipation as noted previously.

Nor has the Examiner shown that Astiz’s “object information transmitting unit” (a feature that has not been clearly mapped to a corresponding element in Astiz in any event) would necessarily not transmit content to the “central control unit” which the Examiner presumably equates to Astiz’s data processor 30 (*see* Ans. 4))—a unit that likewise includes the HTTP server 33. *See* FF 1-2. In short, the Examiner has failed to show that Astiz necessarily discloses every element of claim 2.

We are therefore persuaded that the Examiner erred in rejecting independent claim 2, and dependent claims 3, 5, and 6 for similar reasons.

CONCLUSION

The Examiner erred in rejecting claims 1-27 under § 102.

ORDER

The Examiner’s decision rejecting claims 1-27 is reversed.

REVERSED

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